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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
88/819,412	03/21/98	WOLF INBARGER	L 152-115P-DIV

QM31/0414

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EXAMINER	
NGUYEN, A	
ART UNIT	PAPER NUMBER
3734	

DATE MAILED: 04/14/98

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No.
08/619,412

Applicant(s)
Lloyd WOLFINGARGER JR.

Examiner
Nguyen, AT

Group Art Unit
3734

☒ Responsive to communication(s) filed on Jan 16, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 59-75 is/are pending in the application.

Of the above, claim(s) 66 and 72-75 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 59-65 and 67-71 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 9

☒ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION***Double Patenting***

1. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and © may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 59-65, and 67-⁷¹~~72~~ are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-58 of U.S. Patent No. 5,556,379.

Although the conflicting claims are not identical, they are not patentably distinct from each other because omission of an element(s) along with its function(s) is considered to be obvious to one of ordinary skill in the art, in which, the claims become broader, thereby, would extend the monopoly of the patent. The pending claims are apparently broader, i.e., they do not include the process of selecting an intact bone; a process of removing excess cartilage from at least one articulating surface of the bone, preparing an opening through the cortical layer of the bone to permit access of a vacuum line to the bone cavity; and immersing the bone in a solution within a container.

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Allowable Subject Matter

3. Upon receiving a timely filed terminal disclaimer at the Office, claims 59-65, and 67-~~72~~⁷¹ will be allowable over the prior of record. The allowable subject matter is, while the applicant has filed a declaration under 37 C.F.R. Rule 1.131(a) to overcome the Morse reference (5,556,379), and that the prior art of record do not disclose or fairly suggest, a process for cleaning an essentially intact bone comprising applying a vacuum to an essentially intact bone to draw solution comprising at least one solvent for bone marrow through the intact bone to solubilize bone marrow.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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5. Any inquiry concerning this or earlier communications should be directed to Examiner Nguyen, A. T. at telephone number (703) 308-2154.

In the event if attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mrs. Wynn Wood Coggins, can be reached at (703) 308-1344.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858.


A. T. Nguyen
04/09/98

WYNN WOOD COGGINS
PRIMARY EXAMINER
